

Notice of Allowability

Application No.

10/084,960

Examiner

Joseph T. Voitach

Applicant(s)

HESCHELER, JURGEN

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 2/3/2006.
2. ☒ The allowed claim(s) is/are 78-80.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 8, 2005 has been entered.

DETAILED ACTION

This application filed February 28, 2002 is a continuation of 09/446,717 filed 04/13/2000, now abandoned, which is a national stage entry of PCT/EP98/03988 with the international filing date of June 30, 1998.

Applicant's amendment filed February 3, 2006, has been received and entered. Claims 1-77 have been canceled. Claims 78-80 have been added. Claims 78-80 are pending.

Election/Restrictions

Applicant's election without traverse of Group I, claims 32-41, in the reply filed on June 3, 2004 was acknowledged.

It is noted that newly added claims are generally drawn to the elected invention. While claims encompassing only the construct (i.e. new claim 80) were never specifically presented, it does not present a burden to examine this invention with the cell culture claims.

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Claims 78-80 drawn to a cell culture cell-type or development-specific expression of a fluorescent protein, and the construct used therein are currently under examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention is withdrawn.

Newly submitted claims do encompass the issues raised in the previous rejection. More specifically, it is noted that claim 41 was specifically excluded from the previous rejection.

Newly submitted claims are drawn to the invention encompassed by claim 41.

Claim Rejections - 35 USC 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims rejected under 35 U.S.C. 102(b) as being clearly anticipated by Zernicka-Goetz *et al.* is withdrawn.

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Newly submitted claims require pCX-(α -act)GFP-Neo (DSM 11633) which Zernicka-Goetz *et al.* fails to teach.

Claim Rejections - 35 USC 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims rejected under 35 U.S.C. 103(a) as being unpatentable over Zernicka-Goetz *et al.* in view of Ikawa *et al.* and in further view of Wobus *et al.*, Sartorelli *et al.* and Chen *et al.* is withdrawn.

Claims rejected and newly added claims 54-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zernicka-Goetz *et al.*, Ikawa *et al.*, Wobus *et al.*, Sartorelli *et al.* and Chen *et al.* in view of Maltsev *et al.* (Circulation Research, 75:233-244) or Rohwedel *et al.* (Developmental Biology 164:87-101) is withdrawn.

Newly submitted claims require pCX-(α -act)GFP-Neo (DSM 11633) which Zernicka-Goetz *et al.*, Ikawa *et al.*, Wobus *et al.*, Sartorelli *et al.* and Chen *et al.* or Zernicka-Goetz *et al.*, Ikawa *et al.*, Wobus *et al.*, Sartorelli *et al.*, and Chen *et al.* in view of Maltsev *et al.* or Rohwedel *et al.* fails to anticipate or make obvious.

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Reasons for Allowance

The following is an examiner's statement of reasons for allowance:

As indicated previously, claims to the specific vector deposited as DSM11633 are free of the art of record because the art fails to teach the specific construct provided in this deposit. The claims have been amended to be or to require the presence of pCX-(α -act)GFP-Neo (DSM 11633).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (571) 272-0739.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached at (571) 272-0735.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Dianiece Jacobs whose telephone number is (571) 272-0532.

Joseph T. Woitach

JOSEPH T. WOITACH, PH.D.
PRIMARY EXAMINER

Joseph T. Woitach
A01632